

DEC 26 2006

Application No.: 10/803,114

Docket No.: UC0401USNA

**Remarks**Status of the Application

Claims 3, 6-9, and 11-28 are pending in the application. Applicants note with appreciation that Claims 14-21 are allowed. No claims are amended.

Non-Statutory Double Patenting Not Established

Claims 3, 6-9, 11-13, and 24-28 have been provisionally rejected based upon nonstatutory obviousness-type double patenting as unpatentable over Claims 1-3 of copending Application No. 11/165,158; Claims 1-8 of copending Application No. 10/802,704; Claims 1-3 and 7-10 of copending Application No. 10/814,917; and Claims 1-9 of copending Application No. 10/802,138. Applicants respectfully traverse the rejections.

These rejections are improper because the Office Action did not establish a *prima facie* case of obviousness. Obviousness-type double patenting analysis turns on the Graham factors.

*Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966), requires that to make out a case of obviousness, one must: (A)determine the scope and contents of the prior art; (B)ascertain the differences between the prior art and the claims in issue; (C)determine the level of skill in the pertinent art; and (D)evaluate any evidence of secondary considerations. If a *prima facie* case is established, the burden shifts to applicant to come forward with rebuttal evidence or argument to overcome the *prima facie* case.

MPEP § 2144.08.II. Furthermore,

Any obviousness-type double patenting rejection should make clear: (A)The differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and (B)The *reasons* why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is anticipated by, or would have been an obvious variation of, the invention defined in a claim in the patent.

MPEP § 804.II.B.1 (emphasis added).

Application No.: 10/803,114  
Docket No.: UC0401USNA

Here, the Office Action merely states "the instant claims and the above listed claims of the copending applications are drawn to *aqueous dispersions* containing a polythiophene and a colloid-forming polymeric acid. The instant claims are fully encompassed by each of the copending compositions." (emphasis added). To the contrary, none of the copending applications teach or suggest a dispersion "in a liquid medium comprising at least 60% by weight at least one organic liquid" as claimed in independent Claim 24.

For example, Application No. 10/802,138 recites that aqueous "refers to a liquid that has water in a major portion" (i.e., greater than 50%). *Id.* at para. [0044]. Such an aqueous liquid cannot, by necessity, be "in a liquid medium comprising at least 60% by weight at least one organic liquid" as claimed in independent Claim 24.

Also, the Office Action has failed to establish a reason why one of ordinary skill in the art would conclude that the invention is either anticipated or obvious. The Office Action merely states that "the instant claims are fully encompassed by each of the copending compositions." This conclusory statement does not contain a sufficient reason of why one of ordinary skill in the art would find the current invention either anticipated or obvious. The Office has failed to establish a *prima facie* case of obviousness, thus, the rejection is improper.

#### Anticipation and/or Obviousness Not Established

Claims 3, 6-9, 11-13, and 24-28 stand rejected as anticipated by or in the alternative obvious with respect to EP 0593111 (EP '111). Applicants respectfully traverse the rejection, as it fails to teach each and every element set forth in claims as found. Furthermore, Applicants respectfully traverse the alternative obviousness rejection as the Office fails to establish a *prima facie* case of obviousness.

"A claim is anticipated only if *each and every* element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference" MPEP § 2131 (emphasis added). For example, Independent Claim 24 recites:

A composition comprising at least one polymer selected from the group consisting of a polypyrrole, a polythiophene, and a combination of such polymers, and at least one colloid-forming *fluorinated* polymeric sulfonic acid dispersed in a liquid medium comprising *at least 60% by weight at least one organic liquid*.

Application No.: 10/803,114

Docket No.: UC0401USNA

(emphasis added). Here, EP '111 does not describe a *fluorinated* polymeric sulfonic acid. Furthermore, EP '111 does not disclose a dispersion in a liquid medium comprising *at least 60% by weight at least one organic liquid*. Accordingly, EP '111 does not anticipate Claim 24 of the present application since *each and every* element of Claim 24 is neither expressly or inherently described, in EP '111. Because Claims 3, 6-9, 11-13, 22, 23, and 25-28 depend from Claim 24, EP '111 does not anticipate these dependent claims either.

Regarding the rejection in the alternative of Claims 3, 6-9, 11-13, and 24-28, the Office has not met its initial burden to establish a *prima facie* case of obviousness. Indeed, EP '111 does not teach or suggest all of the claim limitations as previously addressed, and furthermore, the Office Action does not establish suggestion or motivation to modify the reference to meet the claims. Merely stating that "such modifications are well within the purview of the skilled artisan" does not proffer a reason why one would want to modify the EP '111 teachings to meet the present claims, as required by the MPEP. The Office Action has not established a *prima facie* case of obviousness for Claims 3, 6-9, 11-13, and 24-28.

#### Obviousness Not Established

The Office Action rejects Claims 22 and 23 as obvious over EP '111 as applied to Claims 3, 6-9, 11-13, and 24-28 and further in view of Pickup et al. ("the Pickup reference"). Applicants respectfully traverse the rejection as the Office fails to establish a *prima facie* case of obviousness.

Claims 22 and 23 are not obvious over EP '111 and the Pickup reference, whether taken in combination or separately. EP '111 does not teach a dispersion "in a liquid medium comprising *at least 60% by weight at least one organic liquid*." Furthermore, the Pickup reference does not cure this deficiency. For example, there is no discussion of the compositions in the Pickup reference being in a liquid medium comprising *at least 60% by weight at least one organic liquid*.

#### Conclusion

Applicants respectfully solicit a notice of allowance. Should the Examiner have questions, the Examiner is invited to call the undersigned at the telephone number listed below.

Application No.: 10/803,114  
Docket No.: UC0401USNA

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